

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1, 2, 4-7, 9, 10, 12 and 17-27 are now present in this application. Claims 1, 9, 17, 23, 26 and 27 are independent. Reconsideration of this application is respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1, 2, 4-6, 9, 10, 12, 17-21 and 23-27 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication 2002/0048105 to Shin et al. (English Translation – KR 2000-43865), hereinafter referred to as “Shin”. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Applicant respectfully submits that Shin does not constitute prior art to Applicant under 35 USC §102(e), which is the statutory basis on which this rejection is based.

35 USC §102(e) states, in pertinent part, that “[A] person shall be entitled to a patent unless . . . (e) the invention was described in – (1) an application for patent, published under section 122(b), by another **filed in the United States before the invention by the applicant** for patent . . . **(emphasis added).**”

Applicant believes that this means that the earliest effective filing date of Shin under 35 USC §102(e) is the date that Shin was “filed in the United States,” which was July 20, 2001.

However, Applicant removed Shin as a reference under 35 USC §102(e) by filing is an accurate English translation of Applicant's priority Application, i.e., Republic of Korea Patent Application No. 00-79905, filed December 21, 2000, which is prior to the effective filing date of the applied Shin patent application publication. The English language translation perfected Applicant's priority benefit under 35 USC §1.119, and removes Shin as a reference, making Shin's effective filing date under 35 USC §102(e) of July 20, 2001, after Applicant's effective filing date of December 21, 2000.

The Office Action is improperly contending that Shin is prior art as of its foreign filing date in Korea. This is prohibited by the clear terms of the statute, i.e., 35 USC §102(e), and also by a longstanding case law holding of the Court of Customs and Patent Appeals, In re Hilmer, 149 USPQ 480 (CCPA 1966), and subsequently adopted by, and approved by, the Court of Appeals for the Federal Circuit. See, for example, In re Deckler, 24 USPQ2d 1448 (Fed. Cir. 1992).

The English language translation of Shin's Korean priority application, which was not received by Applicant as part of this Office Action, cannot change the statute or the case law interpreting that statute. As the Court explained in the Hilmer decision, 35 USC §119 may be used by an Applicant as a shield, as Applicant has used it, but not as a sword, as the Office Action is trying to use it.

As an alternative, in order to be completely responsive to the merits of the rejection, Applicant presents the following arguments to traverse the merits of the rejection.

The only information that Shin displays is "certain descriptive information such as title of song and the artists name" as disclosed on page 1, paragraph [0006] of Shin. Shin does not display a directory structure in general, or a mark in general, or a mark on a directory structure as recited in claim 1. Nor does Shin display a selected directory excluding a non-selected directory as recited in claim 9. Nor does Shin disclose computer generated means for displaying a directory structure in general, or a mark in general, or for displaying a mark on a directory structure as recited in claim 17. Nor does Shin disclose computerized means for displaying a selected directory excluding a non-selected directory, as recited in claim 23. Nor does Shin disclose computerized displaying of composed directory-display information, as recited in claim 26. Nor does Shin disclose computerized means for displaying composed directory-display information, as recited in claim 27.

Accordingly, this rejection is improper and should be withdrawn.

Rejections under 35 U.S.C. §103

Claims 7 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shin in view of U.S Patent No. 6,067,282 to Moriyama et al. ("Moriyama"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293,

227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

As noted above, Applicant has filed an accurate English language translation of Applicant’s priority Application, i.e., Republic of Korea Patent Application No. 00-79905, filed December 21, 2000, which is prior to the effective filing date of the applied Shin patent application publication under 35 USC §102(e), i.e., Shin’s filing date in the United States, which is July 20, 2001. This English language translation perfects Applicant’s priority benefit under 35 USC §1.119, and removes Shin as a reference, making Shin’s effective filing date under 35 USC §102(e) of July 20, 2001, after Applicant’s effective filing date of December 21, 2000.

For this reason alone, the rejection is improper and should be withdrawn.

However, in order to be fully responsive to the outstanding rejection, Applicant respectfully notes that Shin does not anticipate claim 1, from which claim 7 depends or claim 17, from which

claim 22 depends and, based on the reasons stated above in the traversal of the rejection of claims 1 and 17, from which claims 8 and 22, respectively, depend. Moreover Moriyama is not applied to remedy the deficiencies of Shin. Accordingly, even if it were obvious to modify Shin in view of Moriyama, the suggested modified version of Shin would not render the claimed invention obvious because it would still have the aforementioned deficiencies.

The Office Action admits that Shin does not disclose a numerical mark on a file.

In an attempt to remedy this admitted deficiency, the Office Action turns to Moriyama, which is said to provide a mark for visually differentiating a directory, and concludes that it would be obvious to modify Shin in view of Moriyama because Moriyama provides a numerical representation related to a file in the directory for providing a user with more information for locating a file.

Applicant respectfully disagrees for a number of reasons.

Firstly, Shin does not display a directory. Rather, Shin only displays user information concerning the title of a song and the artist's name of a particular MP3 file if it is desired to retrieve a file and display such information— see paragraph [0007].

Secondly, Shin clearly accomplishes its objectives without displaying a directory in general, let alone a directory with a mark on it, or a directory with a mark indicating the number of files in it. Therefore, one of ordinary skill in the art would have no incentive to display the number of files in a directory with a mark.

Thirdly, Moriyama does not appear to disclose marking a directory with the number of files in it, so its relevance to the claimed invention or to Shin is not clear.

Thus, the Office Action fails to provide objective factual evidence of proper motivation to turn to Moriyama to modify Shin in any way, let alone to indicate the number of files in a directory.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention recited in claims 7 and 22.

Reconsideration and withdrawal of this rejection of claims 7 and 22 are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

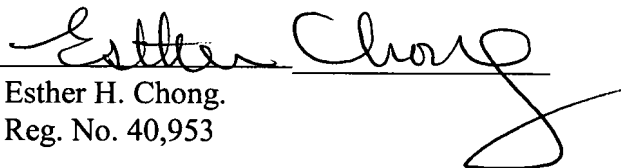
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8076, in the Washington, D.C. area.

Prompt and favorable consideration of this Substitute Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 
Esther H. Chong.
Reg. No. 40,953

EHC/RJW:mmi:tm 

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000